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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,649	01/27/2004	Younger Ahluwalia	03137.000006	4007

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30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,649

Applicant(s)

AHLUWALIA ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-6, 8-12, 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/20/04, 7/15/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of category I, species as set forth in claim 1; category II, species as set forth in claims 3 or 7; category III, species as set forth in claim 6; category IV, species as set forth in claim 13; and category V, aluminum foil in the reply filed on 9/22/2005 is acknowledged. The traversal is on the ground(s) that "Claim 1 is generic to all the claims. Claims 2-20 include additional limitations not found in claim 1 ... all the claims are readable on the elected species". This is not found persuasive because, for example, clearly claims 1 and 2 are distinct in structure. Specifically, claim 1 does not require the presence of a substrate, whereas claim 2 requires a substrate, and they are *structurally distinct and independent* species, Applicants argument to the contrary notwithstanding. In summary, the elected claims are 1, 7, 13 and 16-20. Claims 2-6, 8-12, 14 and 15 are withdrawn from further consideration.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 7, 13 and 16-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 7, 8 and 16-19 of copending Application No. 10/766652. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1, 7, 13 and 16-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 13 and 16-21 of copending Application No. 10/766654 in view of Zucker et al. (US 4357436).

The claims of copending Application '654 lack an express disclosure that glass microspheres (a prefabricated microcells) are suitable filler for forming a thermal insulation board. However, it is noted Zucker's invention is directed to a thermal insulation material (abstract), and Zucker expressly teaches that suitable fillers for an

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insulation material include diatomaceous silica (i.e., clay), glass microspheres, etc. (column 2, lines 51-63). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art of thermal insulation material to include glass microspheres, as taught by Zucker, as a filler of copending Application '654. It should be noted that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

This is a provisional obviousness-type double patenting rejection.

5. Claims 1, 7, 13 and 16-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 13 and 15-17 of copending Application No. 10/766678 in view of Zucker et al. (US 4357436).

The claims of copending Application '678 lack an express disclosure that glass microspheres (a prefabricated microcells) are suitable filler for forming a thermal insulation board. However, it is noted Zucker's invention is directed to a thermal insulation material (abstract), and Zucker expressly teaches that suitable fillers for an insulation material include diatomaceous silica (i.e., clay), glass microspheres, etc. (column 2, lines 51-63). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art of thermal insulation material to include glass microspheres, as taught by Zucker, as a filler of copending Application '654, motivated by the desire to obtain a low cost insulation board.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 7, 13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horner, Jr. et al. (US 6365533) in view of Zucker et al. (US 4357436).

Horner's invention is directed to an insulation board comprising a fiber mat containing a binder for the fibers, coated with a prefoamed composition which contains a thixotropic polymer latex, a foam sustaining surfactant, and a flame retarding filler (abstract). One of the first and second facers can be of the same or of a different composition, and may be selected from those conventionally employed, such as aluminum foil, etc. (column 6, lines 3-10).

For claims 1, 7, 13 and 16-20, Horner lacks an express teaching that glass microspheres (a prefabricated microcells) are suitable filler for forming a thermal insulation board. However, it is noted Zucker's invention is directed to a thermal insulation material (abstract), and Zucker expressly teaches that suitable fillers for an insulation material include diatomaceous silica (i.e., clay), glass microspheres, etc. (column 2, lines 51-63). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art of thermal insulation material to include glass microspheres, as taught by Zucker, as a filler of Horner's insulation board. It

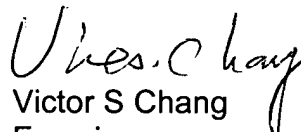
should be noted that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor S Chang
Examiner
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11/7/2005